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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,932	11/21/2001	Robert J. Sicurelli JR.	211014SicFlxCIP	4222
4988	7590	03/30/2009		
ALFRED M. WALKER 225 OLD COUNTRY ROAD MELVILLE, NY 11747-2712			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 03/30/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,932

Applicant(s)

SICURELLI ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-35, 38-40, 42, 44-46, 50, 52-55, 58-61, 64, 65, 70-78 and 80-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35, 38-40, 42, 44-46, 50, 52-55, 58-61, 64, 65, 70-78 and 80-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35, 38-40, 42, 44-46, 50, 52-55, 58-61, 64, 65, 70-78 and 80-108 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added language to the claims of a modulus of elasticity “along a longitudinal axis of the prefabricated post” is not supported by the disclosure as originally filed. Applicant points to Figs. 12, 12A and 12B for support, however, these figures merely show using straight fibers. There is nothing in these figures that teaches that the referred to modulus of elasticity is limited to being along a longitudinal axis as now claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 35, 38, 42, 44-46, 50, 53-55, 58-61, 64, 65, 70, 71, 74-78, 80-82, 84, 85, 88, 89, 91-103 and 105-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929). Reynaud shows a prefabricated post comprising a bundle of non-metallic and non-woven fibers 5 in a resin 4. The fibers and resin of Reynaud are inherently flexible to some degree, however, Reynaud shows using carbon fibers not glass. Albert teaches the use of alternative fibers including carbon or glass, column 2, lines 59-65. It would be obvious to one of ordinary skill in the art to modify Reynaud to include the use of glass fibers as suggested by Albert in order to make use of known alternative materials in order to obtain the desired known properties of those materials. Reynaud teaches matching properties of the tooth including the modulus of elasticity. With respect to using a modulus of elasticity taken along a longitudinal axis, it would be obvious to match the tooth along a line of major force such as straight up and down biting. To use the inherently more flexible glass to better match such properties would have been obvious to one of ordinary skill in the art. The specific shape of the post used is an obvious matter of choice in shape to best match the canal. To include force vectoring and to approximately match the flexibility of a natural tooth are obvious matters of choice in the degree of matching the tooth properties to one of ordinary skill in the art. The specific type of glass fibers used is an obvious matter of choice in known materials to one of ordinary skill in the art. The specific type of resin used is an obvious matter of choice in the use of known materials to the skilled artisan. To include surface texturing or facets are well known to one of ordinary skill in the post art in order to improve the hold in the tooth canal. To call the post, a pin, is merely terminology, and therefore, is not given patentable weight. Reynaud shows compacted fibers in the drawings, however, does not state a type or degree of compacting. The

limitation “loosely” is a relative term that describes a degree of compacting that can depend on comparison and/or interpretation, and as such, the degree of compactness of the fibers is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art. Reynaud does not show twisted fibers. Albert shows twisted fibers in Figs. 4 and 8. It would be obvious to one of ordinary skill in the art to modify Reynaud to include twisting the fibers as shown by Albert in order to make use of known shapes to obtain the desired properties. The shown structure of Reynaud is inherently capable of being positioned above the coronal end of a tooth canal in use. The structure of Reynaud is inherently capable of being selectively flared depending on the intended use. With respect to claims 105-108, to use medical grade fibers in a device that is intended to be placed within the body would have been obvious to one of ordinary skill in the art in order to not harm the patient. The combination will inherently include the property of stress relief.

Claims 34 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Al

Kasem (5326264). The above combination does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claims 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Weissman (5326263). The above combination does not show a end shaped to be rounded and to direct light. Weissman shows an end shaped to direct light, Fig. 6, that can be rounded, column 5, lines 1-3 and column 6, lines 1-4, and to direct light. It would be obvious to one of ordinary skill in the art to modify the above combination to include a shaped end as shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) and Al Kasem (5326264) as applied to the claim 39 above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claims 83, 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Nordin (5282747). The above combination does not show a core spacer. Nordin shows a core spacer 46. It would be obvious to one of ordinary skill in the art to modify the above combination to include a core spacer as shown by Nordin in order to better hold a crown.

Claims 33, 35, 38, 42, 44-46, 50, 53-55, 58-61, 64, 65, 70, 71, 74, 77, 95, 97-99, 105 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012). Reynaud shows a post comprising a bundle of non-metallic and non-woven fibers 5 in a resin 4. The fibers and resin of Reynaud are inherently flexible to some degree, however, Reynaud shows using carbon fibers not fiberglass. Goldberg teaches the use of alternative fibers including carbon or glass, column 6, lines 13-19, for producing dental appliances. It would be obvious to one of ordinary skill in the art to modify Reynaud to include the use of glass fibers as suggested by Goldberg in order to make use of common alternative

materials in order to obtain the desired known properties of those materials, the combination being further obvious because teaches the use of many different reinforcing fibers, and gives no criticality to the use of fiberglass. Reynaud teaches matching properties of the tooth including the modulus of elasticity. With respect to using a modulus of elasticity taken along a longitudinal axis, it would be obvious to match the tooth along a line of major force such as straight up and down biting. To use the inherently more flexible glass to better match such properties would have been obvious to one of ordinary skill in the art. To include force vectoring and to approximately match the flexibility of a natural tooth are obvious matters of choice in the degree of matching the tooth properties to one of ordinary skill in the art. The specific shape of the post used is an obvious matter of choice in shape to best match the canal. The specific type of glass fibers used is an obvious matter of choice in known materials to one of ordinary skill in the art. The specific type of resin used is an obvious matter of choice in the use of known materials to the skilled artisan. To include surface texturing or facets are well known to one of ordinary skill in the post art in order to improve the hold in the tooth. To call the post, a pin, is merely terminology, and therefore, is not given patentable weight. Reynaud shows compacted fibers in the drawings, however, does not state a type or degree of compacting. The limitation "loosely" is a relative term that describes a degree of compacting that can depend on comparison and/or interpretation, and as such, the degree of compactness of the fibers is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art. With respect to claims 105 and 106, to use medical grade fibers in a device that is intended to be placed within the body would have been obvious to one of ordinary skill in the art in order to not harm the patient. The combination will inherently include the property of stress relief.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Al Kasem (5326264). The above combination does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claims 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Weissman (5326263). The above combination does not show a end shaped to be rounded and to direct light. Weissman shows an end shaped to direct light, Fig. 6, that can be rounded, column 5, lines 1-3 and column 6, lines 1-4, and to direct light. It would be obvious to one of ordinary skill in the art to modify the above combination to include a shaped end as

shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Al Kasem (5326264) as applied to the claim 39 above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claims 75, 76, 78, 80-82, 84, 85, 88, 89, 91, 96, 100-103, 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied above, and further in view of Himmel et al (GB 2214087). The above combination does not show twisted fibers. Himmel shows twisting fibers, page 3, last paragraph. It would be obvious to one of ordinary skill in the art to modify the above combination to include twisting the fibers as shown by Himmel in order to make use of known shapes to obtain the desired properties. The shown structure of Reynaud is inherently capable of being positioned above the coronal end of a tooth canal in use. The structure of Reynaud is inherently capable of being selectively flared depending on the intended use. With respect to claims 107 and 108, to use medical grade fibers in a device that is intended to be placed within the body would have

been obvious to one of ordinary skill in the art in order to not harm the patient. The combination will inherently include the property of stress relief.

Claims 83, 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Himmel et al (GB 2214087) as applied to claim 78 above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Himmel et al (GB 2214087) as applied to claim 102 above, and further in view of Nordin (5282747). The above combination does not show a core spacer. Nordin shows a core spacer 46. It would be obvious to one of ordinary skill

in the art to modify the above combination to include a core spacer as shown by Nordin in order to better hold a crown.

Response to Arguments

Applicant's arguments filed January 2, 2009 have been fully considered but they are not persuasive. With respect to the new language added to the claims, as stated in the rejections above, the original disclosure does not support it. With respect to Alpert not being prior art, applicant is directed to responses made before in previous actions. With respect to other prior art, the repeated remarks are held to be adequately responded to in previous actions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***/John J Wilson/
Primary Examiner
Art Unit 3732***

March 23, 2009